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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/054,884

01/25/2002

Masato Minami

03560,002446.1

7163

5514 7590 11/12/2003

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EXAMINER

RAMSEY, KENNETH J

ART UNIT

PAPER NUMBER

2879

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,884

Applicant(s)

MINAMI ET AL.

Examiner

Kenneth J. Ramsey

Art Unit

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/388,427.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 26 of U.S. Patent No. 6,383,047 in view of Yamanobe EP(788,130). The invention of claim 26, comprises applying a n electroconductive film comprising polyacrylo nitrile and conductive material between a plurality of pairs of electrodes and a step of forming a gap in the electroconductive film by applying a voltage between the electrodes, wherein the electroconductive film is applied by an ink jet device. Claim 26 differs from the claims by requiring the presence of amorphous carbon or graphite as the electroconductive material in the polyacryllo nitrile film prior to forming the gap and that amorphous carbon or graphite is formed in the film facing the newly formed gap. Yamanobe discloses a similar process of applying a voltage to a polyimide or polyacrylnitrile polymer coated electroconductive film to form a gap. In Yamanobe, it is disclosed that glassy (amorphous) carbon (page 9, line 33) or

graphite (page 9, line 36) is present in the film facing the gap after the forming step. As to claims 17, 20 and 21, since the polymer film of patent claim 26 must be conductive, it would have been obvious to one of ordinary skill in the art at the time of applicants' invention to include conductive particles such as metal or graphite in the polymer to control the conductivity of the film since Yamanobe discloses the use of carbon as the electroconductive material at page 8, lines 23-29 and since graphite or amorphous carbon are well known to be conductive as shown by Yamanobe at page 9, lines 31-34 and 35-37. It is the examiner's position that at least amorphous carbon or graphite would be formed in the film facing the gap in the process of claim 26 as modified by Yamanobe since essentially the same carbon material (polyacrylonitrile) is used in patent claim 26 as in Yamanobe. Thus claims 17, 19, 20 and 22-24 are clearly obvious over claim 26 of the patent. As to claim 18, Yamanobe discloses the use of toluene sulfonate, polyimide and polyacrylonitrile polymers which are all aromatic.

Allowable Subject Matter

The claims would be allowable if a terminal disclaimer is filed since the prior art does not teach or suggest the step of including graphite or amorphous carbon in the polymer film during step b, to make the film electroconductive, prior to the step of forming a gap in the film.

Response to Arguments

Applicant's arguments filed September 17, 2003 have been fully considered but they are not persuasive. Since patent claim requires an electroconductive material in the polymer film and since Yamanobe teaches that the electroconductive film covered

by their polymer film may be a carbon material, it clearly would have been obvious to one of ordinary skill in the art to include graphite or amorphous carbon in the polymer film of patent claim 26 to control the conductivity of the polymer film. The present claims merely differ from Yamanobe by providing the electroconductive carbon directly in the polymer film in lieu of coating the conductive carbon with the polymer. Since patent claim 26 teaches that the electroconductive material may be included in the polymer film, this is not a patentable difference.

Action is made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

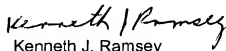
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth J. Ramsey whose telephone number is 308-2324. The examiner can normally be reached on M-F from 9 to 5.

Art Unit: 2879

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (703) 305-4794. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0956.


Kenneth J. Ramsey
Primary Examiner
Art Unit 2879

KJR